

## **REMARKS**

This Response is submitted in reply to the Office Action dated March 12, 2009. Claims 1 to 6, 9 to 13, 15, 16, 18 to 23, 25 to 28, 30 to 32, 34 to 37, 39, 41, 42, 44, 45, 48, 57, 64, 69, 71, 72, 76, 83, 85, 86, 90, 96, 102, and 109 have been amended for clarity. No new matter has been added by such amendments. A Supplemental Information Disclosure Statement and a Terminal Disclaimer are submitted with this Response. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response.

### **Information Disclosure Statement**

Page 2 of the Office Action stated:

[t]he information disclosure statement filed 5/8/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because other references lack page indication and/or date.

A Supplemental Information Disclosure Statement is submitted with this Response which includes the above-mentioned other references with page indication and/or date. Please consider these references in association with the present patent application.

### **Claim Rejections – 35 U.S.C. § 101**

The Office Action rejected Claims 48 to 114 under 35 U.S.C. § 101 and stated such claims are directed to non-statutory subject matter. Applicant respectfully disagrees. For example, independent Claim 48 is directed to a method of operating a gaming device which includes, among other elements, providing the player an award based on at least two of the ending values. Applicant submits that a method of operating a gaming device which provides a player an award based on at least two ending values is directed to statutory subject matter. Nevertheless, to advance the prosecution of this application, Applicant has amended independent Claims 48, 57, 64, 69, 76, 83, 90, 96, 102 and 109 and submits that these amendments overcome these rejections.

### **Claim Rejections – Double Patenting**

The Office Action rejected Claims 1 to 114 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 17 of U.S. Patent No. 6,726,565 to Hughs-Baird (“Hughs-Baird I”). For purposes of advancing the prosecution of this application, Applicant elects to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action’s conclusions or rejections.

The Office Action rejected Claims 1 to 114 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 72 of U.S. Patent No. 6,439,995 to Hughs-Baird et al. (“Hughs-Baird II”).

The Office Action rejected Claims 1 to 114 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 76 of U.S. Patent No. 6,595,854 (“Hughs-Baird III”).

The Office Action rejected Claims 1 to 114 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 40 of U.S. Patent No. 7,182,689 (“Hughs-Baird IV”).

MPEP § 804(II)(B)(1) states:

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s).

Page 6 of the Office Action stated:

Although the conflicting claims are not identical, they are not patentably distinct from each other because Hughs-Baird (‘995, ‘854, ‘689) claims a method and a gaming device having a display and a process performing function of player selection of a starting value and modifiers of claims herein. Also, providing remote play through a network such as internet is claimed by Hughs-Baird (‘995, ‘854, and ‘689).

Applicant respectfully disagrees.

Regarding Hughs-Baird II, representative independent Claim 1 is:

A gaming device having a bonus round comprising:

    a selection group having a plurality of selections wherein at least one selection is an award indicator and at least one selection is a picks indicator;

    a final selection group having a plurality of selections wherein at least one selection is an award indicator; and

    a display device adapted to display the selections to a player, whereby the picks indicator determines the number of selections the player may choose in the final selection group.

On the other hand, amended independent Claim 1 of the present application includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection; (c) forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection; (d) repeating steps (b) to (c) for at least another one of the remaining unassociated starting values; and (e) providing the player an award based on at least two of the ending values. Such different elements evidence that independent Claim 1 of Hughs-Baird II does not anticipate or render obvious the gaming device of amended Claim 1. Accordingly, for at least this reason, Applicant submits that amended independent Claim 1 is patentably distinguished over Claims 1 to 72 of Hughs-Baird II and in condition for allowance. Dependent Claims 2 to 8 depend directly either directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to Claim 1 and because of the additional features recited in these claims.

Independent Claims 9, 15, 18, 25, 30, 34, 39, 44, 48, 57, 64, 69, 76, 83, 90, 96, 102 and 109 each include certain similar elements to independent Claim 1. For reasons similar to those discussed above with respect to independent Claim 1, independent Claims 9, 15, 18, 25, 30, 34, 35 to 39, 40 to 47, 48, 57, 64, 69, 76, 83, 90, 96, 102 and 109 (and dependent Claims 10 to 14, 16, 17, 19 to 24, 26 to 29, 31 to 33, 49 to 56, 58 to 63, 65 to 68, 70 to 75, 77 to 82, 84 to 89, 91 to 95, 97 to 101, 103 to 108 and 110 to 114) are each patentably distinguished over Hughs-Baird II and in condition for allowance.

Regarding Hughs-Baird III, representative independent Claim 1 is:

A gaming device having a game comprising:

a first selection group having a plurality of first selections, wherein at least one of the first selections yields an award indicator and at least one of the first selections yields a picks indicator; and

a second selection group having a plurality of second selections, wherein at least one second selection yields an award indicator, and wherein the picks indicator from the first selection group determines a number of second selections a player may choose in the second selection group, said picks indicator being at least one and less than or equal to the number of second selections in the second selection group.

On the other hand, amended independent Claim 1 of the present application includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection; (c) forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection; (d) repeating steps (b) to (c) for at least another one of the remaining unassociated starting values; and (e) providing the player an

award based on at least two of the ending values. Such different elements evidence that independent Claim 1 of Hughs-Baird III does not anticipate or render obvious the gaming device of amended Claim 1. Accordingly, for at least this reason, Applicant submits that amended independent Claim 1 is patentably distinguished over Claims 1 to 76 of Hughs-Baird III and in condition for allowance. Dependent Claims 2 to 8 depend directly either directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to Claim 1 and because of the additional features recited in these claims.

Independent Claims 9, 15, 18, 25, 30, 34, 39, 44, 48, 57, 64, 69, 76, 83, 90, 96, 102 and 109 each include certain similar elements to independent Claim 1. For reasons similar to those discussed above with respect to independent Claim 1, independent Claims 9, 15, 18, 25, 30, 34, 35 to 39, 40 to 47, 48, 57, 64, 69, 76, 83, 90, 96, 102 and 109 (and dependent Claims 10 to 14, 16, 17, 19 to 24, 26 to 29, 31 to 33, 49 to 56, 58 to 63, 65 to 68, 70 to 75, 77 to 82, 84 to 89, 91 to 95, 97 to 101, 103 to 108 and 110 to 114) are each patentably distinguished over Hughs-Baird III and in condition for allowance.

Regarding Hughs-Baird III, representative independent Claim 1 is:

A gaming device comprising:

    a game operable upon a wager;

    a display device;

    a first selection group including a plurality of first selections displayed by the display device;

    at least one award indicator displayed by the display device after one of the first selections is picked;

    a second selection group including a plurality of second selections;

    at least one award indicator displayed by the display device after one of the second selections is picked; and

    a number of second selection picks in the second selection group, wherein the number of second selection picks is determined, by at least one of the picked first selections associated with a pick value indicator.

On the other hand, amended independent Claim 1 of the present application includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate

with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection; (c) forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection; (d) repeating steps (b) to (c) for at least another one of the remaining unassociated starting values; and (e) providing the player an award based on at least two of the ending values. Such different elements evidence that independent Claim 1 of Hughs-Baird IV does not anticipate or render obvious the gaming device of amended Claim 1. Accordingly, for at least this reason, Applicant submits that amended independent Claim 1 is patentably distinguished over Claims 1 to 40 of Hughs-Baird IV and in condition for allowance. Dependent Claims 2 to 8 depend directly either directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to Claim 1 and because of the additional features recited in these claims.

Independent Claims 9, 15, 18, 25, 30, 34, 39, 44, 48, 57, 64, 69, 76, 83, 90, 96, 102 and 109 each include certain similar elements to independent Claim 1. For reasons similar to those discussed above with respect to independent Claim 1, independent Claims 9, 15, 18, 25, 30, 34, 35 to 39, 40 to 47, 48, 57, 64, 69, 76, 83, 90, 96, 102 and 109 (and dependent Claims 10 to 14, 16, 17, 19 to 24, 26 to 29, 31 to 33, 49 to 56, 58 to 63, 65 to 68, 70 to 75, 77 to 82, 84 to 89, 91 to 95, 97 to 101, 103 to 108 and 110 to 114) are each patentably distinguished over Hughs-Baird IV and in condition for allowance.

### **Claim Rejections – 35 U.S.C. § 102**

The Office Action rejected Claims 1 to 55, 57 to 62, 64 to 67, 69 to 74, 76 to 81, 83 to 88, 90 to 94, 96 to 100, 102 to 107 and 109 to 113 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,309,300 to Glavich (“Glavich”).

Glavich discloses a gaming system that:

provides a main game and a bonus feature with the bonus feature providing for user interaction. In one aspect, user interaction involves allowing a player to select at least some of a plurality of selectable items. When a selectable item is selected, a prize, multiplier or other item associated with the selectable item is revealed and a total bonus prize is based on the prizes, multipliers or other items associated with the selectable items selected by the player. (Abstract)

The bonusing feature of Glavich permits:

a player to select up to a certain number (referred to herein as “Z”) of items out of a plurality (referred to herein as “N”) of selectable items. (Column 3, Lines 59 to 61).

Figs. 3A to 3D of Glavich are set forth below.

FIG. 3A

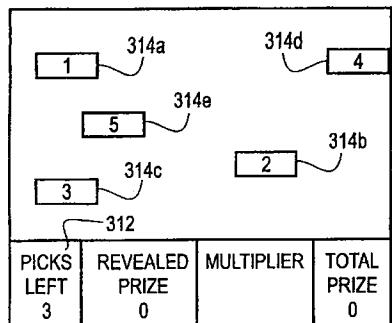


FIG. 3B

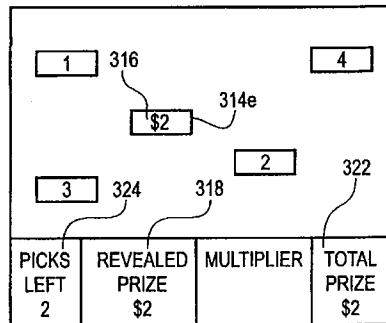


FIG. 3C

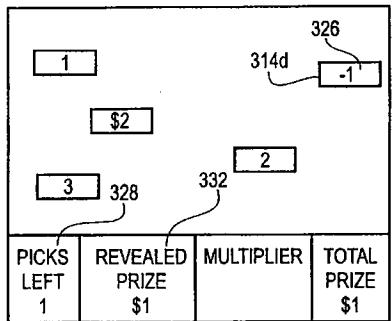
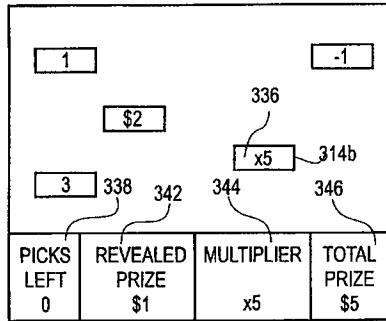


FIG. 3D



Column 6, line 56 to Column 7, line 21 of Glavich discloses:

FIGS. 3A through 3D show screens as they would appear at four subsequent stages during one example of a bonusing feature according to the present invention. In the example illustrated in FIGS. 3A through 3D, the initial value of Z is 3 and the value of N is 5. Thus, as shown in FIG. 3A, the player initially is provided with 3 picks 312 and the display screen displays 5 selectable areas 314a through 314e. In the present example, it is assumed that the player initially selects the fifth area 314e. The apparatus responds by displaying the screen as shown in FIG. 3B in which the value associated with the fifth selectable area 314e is displayed or revealed and, in this case, is a prize value of \$2.00 316. Accordingly, the display shows a current revealed prize of \$2.00 318 and a total prize of \$2.00 322. Because one of the picks has now been used, the display shows that there are now two picks left 324. In the example illustrated, it is assumed the player next selects the fourth selectable item 314d. In this case, the associated item is a demerit value of -1. The fourth selectable area 314d is displayed in a manner to reveal or display this value 326. The number of picks now left is 1 328 and the total revealed prize now totals \$1.00 (332), which is equal to the \$2.00 prize associated with area 314e minus the negative 1 demerit associated with selectable 314d.

[T]he player next selects the second selectable area 314b which, in this example, has an associated item which is a multiplier with a value of x5, which is then revealed or displayed 336. As shown in FIG. 3d, the player has no more picks left 338. The revealed prize is unchanged, i.e., remains at \$1.00 342. However, the revealed prize is increased by the multiplier 344 so that the total prize 346 is \$5.00.

Amended independent Claim 1 is directed to a gaming device which includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection.

Under a first interpretation of Glavich, Applicant submits that if: (i) the Office Action interprets the number of picks of Glavich as the plurality of starting values of the gaming device of amended Claim 1; and (ii) such an interpretation of Glavich begins at a point in time of illustrated Fig. 3A above, then Glavich does not anticipate or render obvious at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection. As described above, the bonusing feature of Glavich permits a player to select a certain number (referred to as "Z") of items out of a plurality (referred to as "N") of selectable items. For example, as shown in Fig. 3A of Glavich, the initial value of Z is three and therefore the player of Glavich is provided with three

picks 312. Each of the displayed number of picks of Glavich (interpreted as the plurality of starting values of the gaming device of amended Claim 1) have the same value (i.e., a value of one pick). That is, if the Office Action interprets this number of picks of Glavich as the plurality of starting values of the gaming device of amended Claim 1, Glavich does not initially display a plurality of starting values wherein at least two of the displayed starting values are different prior to enabling the player to enabling the player to individually associate those different starting values. On the other hand, the gaming device of amended independent Claim 1 includes at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection.

Under a second interpretation of Glavich, Applicant submits that if: (i) the Office Action interprets the displayed number of picks of Glavich as the plurality of starting values of the gaming device of amended Claim 1; (ii) the Office Action interprets selecting an area in Glavich as individually associating a displayed starting value with a selection in the gaming device of amended Claim 1; and (iii) such an interpretation begins at the point in time of illustrated Fig. 3B above, then Glavich does not anticipate or render obvious at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed

selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection. As shown in Fig. 3A above, the player of Glavich is provided with a first value of three (i.e., the three picks left 312). As shown in Fig. 3B above, after the player selects the fifth area 314e (interpreted as individually associating a displayed starting value with a selection in the gaming device of amended Claim 1), Glavich displays two picks are left. That is, if the displayed number of picks of Glavich are interpreted as the starting values of the gaming device of amended independent Claim 1, Glavich does not display at least two different starting values prior to enabling the player to individually associate one of the at least two different starting values with a picked selection. In other words, under this second interpretation, Glavich does not enable a player to individually associate one of a plurality of displayed different picks after initially displaying the plurality of different picks. On the other hand, the gaming device of amended Claim 1 includes, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by: (a) initially displaying: (i) a plurality of starting values to a player, each of the plurality of starting values being greater than zero, and at least two of the plurality of starting values being different; and (ii) a plurality of selections, at least one of the selections being associated with at least one numerical modifier; (b) thereafter: (i) causing one of the displayed selections to be picked; and (ii) enabling the player to individually associate one of the displayed starting values with the picked selection.

Under a third interpretation of Glavich, Applicant submits that if the Office Action interprets: (i) the numbers shown in selectable areas 314a to 314e (see Fig. 3A above) as the plurality of starting values of the gaming device of amended Claim 1; and (ii) the plurality of picks of Glavich as the plurality of selections of the gaming device of amended Claim 1, then Glavich does not anticipate or render obvious at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by forming an ending value based on the

individually associated starting value and any numerical modifier associated with the picked selection. That is, if the numbers shown in selectable areas 314a to 314e are interpreted as the plurality of starting values of the gaming device of amended independent Claim 1, Glavich does not form an ending value based on the plurality of starting values. On the other hand, the gaming device of amended claim 1 includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection.

For at least these reasons, it is respectfully submitted that independent Claim 1 is patentably distinguished over Glavich and in condition for allowance. Dependent Claims 2 to 8 depend either directly or indirectly from amended independent Claim 1 and are also allowable for the reasons given with respect to Claim 1 and because of the additional features recited in these claims.

Independent Claims 9, 15, 30, 48, 57, 64 and 90 each include certain similar elements to independent Claim 1. For reasons similar to those discussed above with respect to independent Claim 1, independent Claims 9, 15, 30, 48, 57, 64 and 90 (and dependent Claims 10 to 14, 16, 17, 31 to 33, 49 to 56, 58 to 63, 65 to 68 and 91 to 95) are each patentably distinguished over Glavich and in condition for allowance.

Amended independent Claim 18 is directed to a gaming device with includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by enabling the player to divide the displayed starting value into a plurality of different starting portions, each of the different starting portions being greater than zero. Applicant submits that Glavich does not anticipate or render obvious enabling the player to divide the starting value into a plurality of different starting portions.

For at least this reason, it is respectfully submitted that independent Claim 18 is patentably distinguished over Glavich and in condition for allowance. Dependent Claims 19 to 24 depend directly from amended independent Claim 18 and are also allowable for the reasons given with respect to Claim 18 and because of the additional features recited in these claims.

Independent Claims 25, 69 and 76 each include certain similar elements to independent Claim 18. For reasons similar to those discussed above with respect to independent Claim 18, independent Claims 25, 69 and 76 (and dependent Claims 26 to 29, 70 to 75 and 77 to 82) are each patentably distinguished over Glavich and in condition for allowance.

Amended independent Claim 34 is directed to a gaming device with includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by (b) enabling the player to accept at least one of the plurality of starting values or to risk at least one of the starting values to obtain at least one ending value; (c) providing the player each starting value, if any, the player accepts; (d) for each starting value, if any, the player risks: (i) enabling the player to individually associate the starting value with a picked selection; and (ii) forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection. Applicant submits that Glavich does not anticipate or render obvious (b) enabling the player to accept at least one of the plurality of starting values or to risk at least one of the starting values to obtain at least one ending value; (c) providing the player each starting value, if any, the player accepts; (d) for each starting value, if any, the player risks: (i) enabling the player to individually associate the starting value with a picked selection; and (ii) forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection.

For at least these reasons, it is respectfully submitted that independent Claim 34 is patentably distinguished over Glavich and in condition for allowance. Dependent

Claims 35 to 38 depend directly from amended independent Claim 34 and are also allowable for the reasons given with respect to Claim 34 and because of the additional features recited in these claims.

Independent Claim 96 includes certain similar elements to independent Claim 34. For reasons similar to those discussed above with respect to independent Claim 34, independent Claim 96 (and dependent Claims 97 to 101) are each patentably distinguished over Glavich and in condition for allowance.

Amended independent Claim 39 is directed to a gaming device with includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by (b) enabling the player to divide the starting value into a plurality of starting portions, each of the starting portions being greater than zero; (c) enabling the player to accept at least one of the plurality of starting portions or to risk at least one of the starting portions to obtain at least one ending portion; (d) providing the player each starting portion, if any, the player accepts; (e) for each starting portion, if any, the player risks: (i) enabling the player to individually associate the starting portion with a selection picked from a plurality of selections, a plurality of the plurality of selection being associated with one of a plurality of numerical modifiers; and (ii) forming an ending portion based on the individually associated starting portion and any numerical modifier associated with the picked selection. Applicant submits that Glavich does not anticipate or render obvious (b) enabling the player to divide the starting value into a plurality of starting portions, each of the starting portions being greater than zero; (c) enabling the player to accept at least one of the plurality of starting portions or to risk at least one of the starting portions to obtain at least one ending portion; (d) providing the player each starting portion, if any, the player accepts; (e) for each starting portion, if any, the player risks: (i) enabling the player to individually associate the starting portion with a selection picked from a plurality of selections, a plurality of the plurality of selection being associated with one of a plurality of numerical modifiers; and (ii) forming an ending portion based on the

individually associated starting portion and any numerical modifier associated with the picked selection.

For at least these reasons, it is respectfully submitted that independent Claim 39 is patentably distinguished over Glavich and in condition for allowance. Dependent Claims 40 to 43 depend directly from amended independent Claim 39 and are also allowable for the reasons given with respect to Claim 39 and because of the additional features recited in these claims.

Independent Claim 102 includes certain similar elements to independent Claim 39. For reasons similar to those discussed above with respect to independent Claim 39, independent Claim 102 (and dependent Claims 103 to 108) are each patentably distinguished over Glavich and in condition for allowance.

Amended independent Claim 44 is directed to a gaming device with includes, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the at least one input device to control a play of a game by (b) enabling the player to forfeit at least one of the starting values in exchange for revealing a numerical modifier associated with at least one of the selections; (c) for each starting value forfeited, revealing the numerical modifier associated with one of the selections; (d) for each starting value not forfeited: (i) enabling the player to individually associate the starting value with a selection picked from the plurality of selections, regardless of whether the numerical modifier associated with the picked selection is revealed or not; and (ii) forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection. Applicant submits that Glavich does not anticipate or render obvious (b) enabling the player to forfeit at least one of the starting values in exchange for revealing a numerical modifier associated with at least one of the selections; (c) for each starting value forfeited, revealing the numerical modifier associated with one of the selections; (d) for each starting value not forfeited: (i) enabling the player to individually associate the starting value with a selection picked from the plurality of selections, regardless of

whether the numerical modifier associated with the picked selection is revealed or not; and (ii) forming an ending value based on the individually associated starting value and any numerical modifier associated with the picked selection.

For at least these reasons, it is respectfully submitted that independent Claim 44 is patentably distinguished over Glavich and in condition for allowance. Dependent Claims 45 to 47 depend directly from amended independent Claim 44 and are also allowable for the reasons given with respect to Claim 44 and because of the additional features recited in these claims.

Independent Claim 109 includes certain similar elements to independent Claim 109. For reasons similar to those discussed above with respect to independent Claim 44, independent Claim 109 (and dependent Claims 110 to 114) are each patentably distinguished over Glavich and in condition for allowance.

Amended independent Claim 83 is directed to a gaming method which includes, among other elements, (b) enabling the player to divide the starting amount into a plurality of different starting portions, wherein each of the different starting portions is greater than zero; (c) causing one of the displayed investment related symbols to be picked; (d) enabling the player to individually associate one of the displayed starting portions with the picked investment related symbol; (e) causing at least one processor to execute the plurality of instructions to form an investment return amount based on the individually associated starting portion and the numerical modifier associated with the picked investment related symbol. Applicant submits that Glavich does not anticipate or render obvious (b) enabling the player to divide the starting amount into a plurality of different starting portions, wherein each of the different starting portions is greater than zero; (c) causing one of the displayed investment related symbols to be picked; (d) enabling the player to individually associate one of the displayed starting portions with the picked investment related symbol; (e) causing at least one processor to execute the plurality of instructions to form an investment return amount based on the individually associated starting portion and the numerical modifier associated with the picked investment related symbol.

For at least these reasons, it is respectfully submitted that independent Claim 83 is patentably distinguished over Glavich and in condition for allowance. Dependent Claims 84 to 89 depend directly from amended independent Claim 83 and are also allowable for the reasons given with respect to Claim 83 and because of the additional features recited in these claims.

### **Claim Rejections – 35 U.S.C. § 103**

The Office Action rejected Claims 55, 56, 62, 63, 67, 68, 74, 75, 81, 82, 88, 89, 94, 95, 100, 101, 107, 108, 113 and 114 under 35 U.S.C. §103(a) as being unpatentable over Glavich in view of U.S. Patent No. 6,311,976 to Yoseloff ("Yoseloff") or U.S. Patent No. 6,174,235 to Walker ("Walker").

Applicant has elected, without prejudice, to disqualify Glavich from being used in such rejection in accordance with 35 U.S.C. §103(c). 35 U.S.C. §103(c) sets forth the following:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Applicant is entitled to disqualify Glavich under 35 U.S.C. §103(c) for the following reasons:

- (a) The claimed subject matter of the present application was developed by inventor Andrea C. Hughs-Baird. The subject matter of Glavich was developed by another person, specifically, inventor Paulina Glavich.
- (b) Glavich qualifies as prior art only under 35 U.S.C. §102(e). Specifically, Glavich claims the benefit of U.S. Provisional Patent Application No. 60/153,746, filed on September 13, 1999. Thereafter, Glavich published on October 30, 2001. The present application claims the benefit of U.S. Patent Application No. 09/963,121, now Patent No. 6,726,565, filed on September 21, 2001. Thus, Glavich is only prior art to the present application under 35 U.S.C. § 102(e).

(c) As of September 21, 2001, the subject matter of Glavich and the present application were owned by the same person, or subject to an obligation of assignment to the same person, for the following reasons:

(i) The present application is owned by IGT, a Nevada corporation. The assignment from the inventor to IGT for the present application was executed on September 21, 2001 and recorded on April 12, 2004. A copy of the Notice of Recordation for the present application is enclosed herewith.

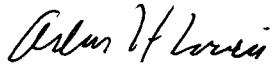
(ii) The assignment from the inventors to International Game Technology for Glavich was recorded on May 4, 2000. The assignment from International Game Technology to IGT for Glavich was executed on October 22, 2002 and recorded on November 4, 2002. A copy of the Patent Assignment Abstract of Title for Glavich is enclosed herewith. On September 13, 1999, IGT was a wholly owned subsidiary of International Game Technology.

Accordingly, Applicant submits that Glavich is disqualified as prior art pursuant to §103(c). The rejection of Claims 55, 56, 62, 63, 67, 68, 74, 75, 81, 82, 88, 89, 94, 95, 100, 101, 107, 108, 113 and 114 rely upon Glavich. With Glavich being disqualified, neither Yoseloff and Walker individually, nor the gaming device resulting from the combination of Yoseloff and Walker anticipate or render obvious the claimed subject matter of Claims 2 to 4, 8 to 10, 12 to 14, 18 to 20, 27 to 28, 38 and 41. Accordingly, for at least these reasons, Applicant respectfully submits that Claims 2 to 4, 8 to 10, 12 to 14, 18 to 20, 27 to 28, 38 and 41 are each patentably distinguished over Glavich in view of Yoseloff and Walker and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance, and allowance is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K & L GATES LLP

BY 

Adam H. Masia  
Reg. No. 35,602  
Customer No. 29159  
Phone: (312) 807-4284

Dated: June 4, 2009



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

OCTOBER 27, 2004

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BELL, BOYD & LLOYD LLC  
ADAM H. MASIA  
P.O. BOX 1135  
CHICAGO, IL 60690-1135

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RECORDATION DATE: 04/12/2004

REEL/FRAME: 015200/0621  
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

HUGHS-BAIRD, ANDREA C.

DOC DATE: 09/18/2001

ASSIGNEE:

IGT  
9295 PROTOTYPE DRIVE  
RENO, NEVADA 89521

SERIAL NUMBER: 10803309

FILING DATE: 03/18/2004

PATENT NUMBER:

ISSUE DATE:

TITLE: GAMING DEVICE HAVING AN INPUT - OUTPUT VALUE BONUS SCHEME

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#### Total Assignments: 2

Patent #: 6309300

Issue Dt: 10/30/2001

Application #: 09564493

Filing Dt: 05/04/2000

Inventor: Paulina Glavich

Title: Gaming bonus apparatus and method with player interaction

#### Assignment: 1

Reel/Frame: 010809/0888

Recorded: 05/04/2000

Pages: 3

Conveyance: ASSIGNMENT OF ASSIGNEES INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: GLAVICH, PAULINA

Exec Dt: 04/04/2000

Assignee: INTERNATIONAL GAME TECHNOLOGY

9295 PROTOTYPE DRIVE

RENO, NEVADA 89511

Correspondent: SHERIDAN ROSS

RICHARD L. HUGHES

1560 BROADWAY, SUITE 1200

DENVER, CO 80202-5141

#### Assignment: 2

Reel/Frame: 013447/0470

Recorded: 11/04/2002

Pages: 5

Conveyance: ASSIGNMENT OF ASSIGNEES INTEREST (SEE DOCUMENT FOR DETAILS).

Assignor: INTERNATIONAL GAME TECHNOLOGY

Exec Dt: 10/22/2002

Assignee: IGT

9295 PROTOTYPE DRIVE

RENO, NEBRASKA 89511

Correspondent: SEYFARTH SHAW

JOSEPH R. LANSER

55 E. MONROE ST., STE. 4200

CHICAGO, IL 60603

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